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SEP 25 2007

OFFICE OF PETITIONS

In re Patent of Corrado	:	
Patent No. 5,731,655	:	
Issue Date: March 24, 1998	:	Decision on Petition
Application No. 08/614,212	:	
Filing Date: March 12, 1996	:	
For: Spark Plug With 360 Degree	:	
Firing Tip	:	

This is a decision on the petition under 37 CFR 1.378(b), filed May 7, 2007, to reinstate the above-identified patent.

The petition is **DISMISSED**.

Facts

The patent issued March 24, 1998.

The 3.5 year maintenance fee could have been timely paid, with a surcharge, as late as Monday, March 25, 2002. The fee was not timely paid and the patent expired.

In order to be eligible for reinstatement under the unintentional standard, a petition under 37 CFR 1.378(c) was due on or before March 24, 2004. A petition under 37 CFR 1.378(c) was filed February 20, 2004. A decision granting the petition was mailed April 1, 2005.

The 7.5 year maintenance fee could have been timely paid, with a surcharge, as late as March 24, 2005. The fee was not timely paid and the patent expired.

The petition states petitioner was unable to afford to pay the fee during March of 2005 because of tax payments required on petitioner's home, mortgage payments, and other expenses.

The instant petition was filed May 7, 2007.

The Law:

A grantable petition under 37 CFR 1.378(b) must be accompanied by a showing to the satisfaction of the Director that the entire delay in paying the required maintenance fee from the

due date for the fee until the filing of a grantable petition pursuant to this paragraph was unavoidable.

In order for a party to prove unavoidable delay, the Office requires the party demonstrate the party exercised the "care or diligence tha[t] is generally used and observed by prudent and careful men in relation to their most important business."¹ However, "the question of whether [delay] was unavoidable [will] be decided on a case-by-case basis, taking all of the facts and circumstances into account."²

The statute requires a "showing" by petitioner. Therefore, petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

The Office and Congress have recognized the unavoidable standard can be very difficult to meet. During 1992, Congress considered the difficulty involved in reinstating a patent under the unavoidable. Congressional representatives described the unavoidable standard as inflexible, extremely hard to meet, too stringent and harsh.³ Congress did NOT take steps to make the unavoidable standard more flexible, easier to meet, less stringent, or less harsh. Instead, Congress determined that it would allow patent owners the ability to reinstate a patent under an "unintentional" standard as long as the petition was filed within 24 months of the expiration of the patent. Congress chose to continue requiring proof of unavoidable delay for petitions filed after the 24 month time period.

Application of the Law to the Facts:

Petitioner has not shown the entire delay in the submission of the 7.5 year maintenance fee was unavoidable.

Petitioner asserts financial difficulty as the cause of delay. A showing of "unavoidable" delay based upon financial difficulty must establish that petitioner lacked the financial resources to timely pay the fee at issue or to file a petition to reinstate earlier. Such a showing must be supported by a complete showing of the responsible person's financial condition during the entire period between March 1, 2005, and April 25, 2007, including income, expenses, assets,

¹ In re Mattulath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912). See also Ray v. Lehman, 55 F.3d 606, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citations omitted) ("[I]n determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person.")

² Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982).

³ "[The unavoidable] standard has been found to be extremely hard to meet. Some patent owners have lost their patent rights due to this inflexible standard." 138 CONG. REC. S16613, 16614 (September 30, 1992) (Rep. DeConcini) (emphasis added). "The unavoidable standard has proved to be too stringent in many cases." 138 CONG. REC. H1115 (October 3, 1992) (Rep. Hughes) (emphasis added). "The unavoidable standard is 'too stringent'. Some patent owners have lost their patent rights due to circumstances that do not warrant this harsh result, but that could not be considered 'unavoidable' under current law." 138 CONG. REC. E1688 (June 4, 1992) (extension of remarks of Rep. McCollum) (emphasis added).

credit and obligations, which made the delay in payment of the maintenance fee unavoidable. Petitioner should provide a month by month analysis of income, expenses, and assets to establish the fact that, at no time, could petitioner have afforded to pay the maintenance fee. Petitioner must establish that petitioner knew of the fee and desired to pay the fee, but simply could not have afforded to pay the fee. Petitioner must prove that petitioner treated the payment of the maintenance fee as petitioner's most important business. If petitioner did not pay the maintenance fee prior to filing the instant petition due to a conclusion the invention lacked sufficient commercial value to justify the expense, then the delay is neither unavoidable nor unintentional. Petitioner should provide copies of any documents or records that would confirm the financial difficulty.

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. The Office notes the credit card number on the instant petition has been redacted/"blanked out."

Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Any petition for reconsideration of this decision must be accompanied by a non-refundable petition fee of \$400 as set forth in 37 CFR 1.17. Since the instant petition was dismissed, the 7.5 year fee and surcharge were not charged to petitioner's credit card. Therefore, any request for reconsideration should also include \$1,150 for the 7.5 year maintenance fee and \$700 for the surcharge. If petitioner wishes to pay fees by credit card, petitioner should use the attached form.

The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.378(e)." .

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director. Therefore, it is extremely important that petitioner supply **any** and **all** relevant information and documentation with his request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides

insufficient evidence to "show" that the delay was unavoidable. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

United States Patent and Trademark Office

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Paperwork Reduction Act Statement

This Credit Card Payment Form (PTO-2038) is approved for use through 02/28/2009 under OMB Control Number 0651-0043. This collection of information is required by 15 U.S.C. § 1113 or 35 U.S.C. § 41 and 37 CFR 1.16-1.28, 1.492, or 2.6-2.7. The information must be provided by a member of the public if he or she chooses to pay a USPTO fee by credit card. This information is also used by the USPTO to charge the appropriate fee amount to the appropriate credit card account. This collection is estimated to take two minutes to complete, including gathering and preparing information and submitting the Credit Card Payment Form (PTO-2038) to the USPTO. Time will vary depending upon the individual case. Please send any comments on the amount of time required to complete this form and/or suggestions for reducing the time burden to the Chief Information Officer, USPTO, PO Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. PLEASE REFER TO THE USPTO WEB SITE, UNDER THE "SITE INDEX" LINK, "MAILING ADDRESSES" LINK FOR THE CORRECT MAILING ADDRESS.

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The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with the request for information solicited on the Credit Card Payment Form (PTO-2038). Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the authority for the collection of this information is 15 U.S.C. § 1113 or 35 U.S.C. § 41 and 37 CFR 1.16-1.28, 1.492, or 2.6-2.7; (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the USPTO is to charge the appropriate fee amount to the appropriate credit card account. If you do not furnish the requested information, the USPTO may not be able to charge the fee to the credit card or the credit card institution may refuse to accept the charge, either of which will result in the fee being treated as not having been paid.

The information provided by you in this form will be subject to the following routine uses:

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- (2) A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
- (3) A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual when the individual has requested assistance from the Member with respect to the subject matter of the record.
- (4) A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform the contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. § 552a(m).
- (5) A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services Administration (GSA), or his designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. § 2904 and § 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.